

REMARKS

This paper is responsive to an Office Action mailed October 3, 2007. Prior to this response, claims 1-27 were pending. After amending claims 1 and 14, claims 1-27 remain pending.

In Section 3 of the Office Action claims 1, 3-14, and 16-27 have been rejected under 35 U.S.C. 102(e) as anticipated by Nishikawa et al. ("Nishikawa"; US 6,934,046). The Office Action states that Nishikawa discloses all the elements of claims 1 and 14. This rejection is traversed as follows.

Nishikawa discloses a print system that converts all print instructions into an intermediate code that is output to the spooler file 303 and called a page description file (PDF), see col. 7, ln. 52-55 and col. 8, ln. 14-18. Once it is determined that a printing operation is to be performed, the spool file sends the PDF to the despooler 305 where the GDI function is regenerated (col. 8, ln. 40-46). The Applicant submits that Nishikawa is describing EMF spooling – a process that defers print data generation until after the jobs have been joined together.

In contrast to Nishikawa's process of joining the print jobs together in the spooling process, the invention of claims 1 and 14 recites a process that joins a plurality of print jobs after despooling. Claims 1 and 14 have been amended to further clarify the differences between Nishikawa and the claimed invention. The claims now recite a process that makes an analysis of whether the economy of joining the jobs exceeds the overhead associated with the joining. If the economy exceeds the overhead penalty, the print jobs are joined.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Nishikawa does not disclose a process that joins together print jobs after despooling, as recited in claims 1 and 14. Neither does Nishikawa disclose a performance analysis that only joins together print jobs if it is economical to do so, as recited in claims 1 and 14. Therefore, Nishikawa does not explicitly disclose every limitation of independent claims 1 and 14. Since Nishikawa does not disclose every limitation of the claimed invention, he cannot anticipate claims 1 and 14. Claims 3-13, dependent from claim 1, and claims 16-27, dependent from claim 14, enjoy the same distinctions from the Nishikawa reference, and the Applicant requests that the rejection be removed.

In Section 5 of the Office Action, claims 2 and 15 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Nishikawa in view of Reilly (US 6,502,147). The Office Action acknowledges that Nishikawa fails to disclose a server located in the printer, but states that Reilly discloses this feature, and that it would have been obvious to include a server computer in a printer to reduce costs. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

The obviousness rejection appears to be based upon the assumption that Nishikawa discloses all the limitations of the base claims 1 and 14. As noted above in response to the anticipation rejection, the Applicant's base claims recite a process that joins together print jobs after despooling, and that performs a performance analysis that only joins together print jobs if it is economical to do so. Nishikawa discloses none of these features. With respect to the third *prima facie* requirement, even if it would have been obvious to incorporate Reilly's server into a printer, the combination of Nishikawa and Reilly still fails to disclose the above-mentioned job joining limitations recited in the Applicant's base claims. Claim 2, dependent from claim 1, and claim 15, dependent from claim 14, enjoy the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to incorporate Reilly's server into Nishikawa to reduce costs. However, even if this assertion was correct, the addition of a server to Nishikawa does not explain how a practitioner in the art could have modified the Nishikawa reference to join together print jobs *after* despooling. Further, the addition of a server does

not suggest that a practitioner would have been motivated to modify Nishikawa to perform a performance analysis that only joins together print jobs if it is economical. The test is not whether there is a motivation to combine prior art references, but rather, does the combination of references suggest a modification that makes the claimed invention obvious.

As noted in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

This analysis is especially relevant if the combination of prior art references does not explicitly disclose every limitation of the claimed invention, as is evident in this case. As noted above in response to the third *prima facie* requirement, even when combined, the references do not disclose all the limitations of claims 1 and 14. Neither does Reilly's server suggest job joining modifications to Nishikawa that would make the Applications limitations obvious.

Alternately, the Examiner may rely upon the knowledge of a person with skill in the art to supply motivation lacking the Nishikawa

and Reilly references. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not include evidence that a process that joins together print jobs after despooling, or a process that performs a performance analysis that only joins together print jobs if it is economical, would have been obvious to an artisan in light of a well-known principle. Neither has evidence been provided that an artisan would have found such a feature desirable.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Nishikawa and Reilly references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the prior art references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claims 1 and 14. Neither has a case been supported that Nishikawa can be modified to supply the missing limitations in view of Reilly. Finally, a case has not been supported that Nishikawa can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 2 and 15 be withdrawn.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,



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